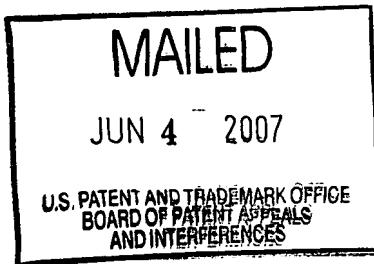


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte QUAN A. VU  
and  
HISATO SHIMA

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Application 09/249,642

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on May 29, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER was mailed October 18, 2005 which requested:

1. consideration of the Information Disclosure Statement

- filed April 10, 2001;
2. appropriate written notification by the examiner to appellants of such consideration;
  3. hold the appeal brief of October 28 defective;
  4. request appellants to file a substitute appeal brief in compliance with 37 CFR § 41.37;
  5. vacate the examiner's answer and submit a revised examiner's answer in compliance with the new rule effective September 13, 2004 in response to the substitute appeal brief; and
  6. for such further action as may be appropriate.

While it is noted that a new Appeal Brief and Reply Brief have been filed and a new Examiner's Answer has been mailed, it still does not appear that the Information Disclosure Statement (IDS) filed April 10, 2001 has been considered. In addition, an IDS was filed on March 1, 2006 which also does not appear to have been considered. It is not apparent from the record whether the examiner considered these statements submitted or notified appellants regarding why their submissions did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

In addition, page 5 of the Appeal Brief filed December 16, 2005 lists the "Grounds of Rejection to be Reviewed on Appeal" as follows:

1. Whether the Claims 1, 2, 4-8, 10-20, 23-25 and 28-31 are properly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,373,821 to Staats (hereinafter “Staats”); and
2. Whether the Claims 21, 22, 26, 27 and 32 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Staats.

While the Examiner’s Answer mailed March 7, 2006 states that “[t]he appellant’s [sic] statement of the grounds of rejection to be reviewed on appeal is correct [page 3], the examiner lists the rejections as follows:

1. Claims 1, 2, 4-8, 10-20 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Staats (US 6,373,821) [page 4] and
2. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staats [page 8].

The Examiner’s Answer is deficient because it fails to include claims 26-32 in the statement of the grounds of rejection. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:  
1) for consideration of the IDSs filed April 10, 2001 and March 1, 2006, and written notification to appellants regarding the Primary Examiner’s decision;

2) for a determination regarding the status of claims 26-32 and inclusion of these claims in the statement of the grounds of rejection; and  
3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: Patrick J. Nolan  
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PJN:psb

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